

REMARKS

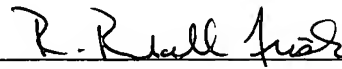
Reconsideration of the present application is respectfully requested. The present application contains claims 1-39 of which, claims 1-31 and 33-36 have been allowed, 32 stands as rejected over Kahan, and claims 37-39 stand rejected over 35 USC § 112.

Claim 32 has been cancelled. Applicant traverses the rejection of claim 32 under 35 USC § 102(b) in view of Kahan and notes that *In re Ngai* does *not* state “that printed matter could not impart patentability”, as argued by the Examiner in support of his rejection of claim 32. The *In re Ngai* court found that the new set of instructions did not “interrelate” with the known kit, noting as the *Gulack* court point out, “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” *In re Ngai*, 367 F.3d 1336, 1339 [70 USPQ2d 1862, 1864] (Fed. Cir.2004), *citing In re Gulack*, 703 F.2d 1381 [217 USPQ 401] (Fed. Cir. 1983). In the present case, the indicia printed on the indicators are specifically related in number and type to a set of golf clubs, which designations are particular to the game of golf. There is interrelation between the indicia, the indicators and the overall kit. Nevertheless, claim 32 has been cancelled in the present application and may be pursued in a subsequent continuation application.

Claims 37-39 have been amended to depend from claim 36, and these claims are now believed to be allowable in view of 35 USC § 112.

In view of the foregoing comments and amendments, the presently pending claims 1-31 and 33-39 are now believed in condition for allowance, and action in accordance therewith is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. Randall Frisk", is written over a horizontal line.

R. Randall Frisk
Reg. No. 32,221
Woodard, Emhardt, Moriarty, McNett
& Henry LLP
Bank One Center Tower
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456

19025-22.RRF.#344529